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PATENT
CUSTOMER NUMBER, 34,986
Docket No. 01084.0011-05000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Richard LEVY

Serial No.: 09/359,809

Filed: July 21, 1999

For: LUBRICANT COMPOSITIONS AND
METHODS

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

APPELLANT'S BRIEF ON APPEAL PURSUANT TO 37 C.F.R. § 41.37 (AMENDED)

The examiner, rather than timely submitting a response to Appellant's July 31, 2006 Appeal Brief (refilled on August 28, 2006 with proof of filing on July 31) delayed responding by 12 months and instead filed a July 11, 2007 office Communication based on an incredibly delayed argument that the Brief did not indicate where the written description supported the elements of the claims and did not include the required appendices. Appellant will address this in the sections that follow, and otherwise submits this brief to set forth the authorities and arguments on which appellant will rely to maintain the appeal.

Appellant paid the \$160.00 fee (small entity) required by 37 C.F.R. § 41.20(b) (2), at the time of filing the August 12, 2002 brief in this application. The Manual of Patent Examining Procedure (M.P.E.P.) §1204.01 waives \$160.00 of the \$250.00 fee due for filing the July 31, 2006 brief, so appellant included payment of the \$90.00 difference with the filing of that brief.

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(i) Real Party in Interest

The inventor assigned the parent application Serial No. 08/487,436, filed June 7, 1995 to Lee County Mosquito Control District. The assignment was recorded at reel 7878, frame 0620 on August 23, 1995, which makes Lee County Mosquito Control District the real party in interest.

(II) Related Appeals and Interferences

Appellant has the following co-pending appeals before the Board of Patent Appeals and Interferences in related applications:

Serial No. 08/943,125 Filed October 3, 1997 (Attorney Docket 01064.0011-02-000)

Serial No. 10/614,114 Filed July 7, 2003 (Attorney Docket 01064.0011-08-0000)

Serial No. 09/357,957 Filed July 23, 1999 (Attorney Docket 01064.0011-04-0000)

The Board of Patent Appeals and Interferences rendered a decision in an appeal on application Serial No. 08/943,125 Filed October 3, 1997 on February 27, 2006, reversing the examiner in all respects, but remanding the application to the examiner for further action. The Patent Office, however, labeled the file jacket of that application as follows:

U. S. PATENT AND TRADEMARK OFFICE
RETURN TO (PTO 1056)
INTERFERENCE SERVICE BRANCH
This case is involved in an
Interference Proceeding

Appellant includes in section "(x) Related proceedings appendix" of this brief the Board's February 27, 2006 decision in application Serial No. 08/943,125 and a certified copy of the file jacket of that application showing the foregoing label regarding the interference. Appellant also included that label as an attachment to appellant's brief in Serial No. 08/943,125. The Patent and Trademark Office has not notified appellant that they have declared an interference in any of the foregoing applications, even though they indicated on the file of application Serial No. 08/943,125 "[t]his case is involved in an Interference Proceeding." The Board also advised,

when contacted by appellant's attorneys by telephone, that the Patent Office had not declared an interference in application Serial No. 08/943,125. Lastly, the Board's decision in the pending appeal could directly affect, or be directly affected by, or having a bearing on the decision in the co-pending appeals. Appellant attaches a copy of

Appellant calls the Board's attention to the United States Patent Application of Martin C. Flautt et al., Serial No. 09/190,868 filed November 13, 1998. Appellant advised the examiner that appellant's Application Serial No. 09/779,588 copies claims from the corresponding Flautt et al. PCT Application WO 00/29486. The Patent and Trademark Office, as of the filing of this brief, has not declared an interference between appellant's Application Serial No. 09/779,588, and Flautt et al., Serial No. 09/190,868.

(III) Status of Claims

As of August 31, 2005 appellant had cancelled claims 1-72 without prejudice or disclaimer, leaving claims 73 - 100 in the application.

(IV) Status of Amendments

The examiner has entered appellant's August 31, 2005 amendment to claims 73, 76, 77, 80-83, and 90.

(V) Summary of Claimed Subject Matter

Concise explanation of the subject matter defined in each of the independent claims involved in the appeal with reference to the page number and line or paragraph numbers of the written description.

Independent claim 73 relates to an aspect of the invention comprising a process for manufacturing a lubricant composition comprising a polymer where the polymer comprises a superabsorbent polymer that absorbs more than about 100 times its weight in water described inter alia in the paragraph bridging pages 20-21 through page 25, line 2. The process involves

combining the polymer with a material for lubricating a surface where the material for lubricating a surface comprises:

- (1) a lubricating metal described inter alia on page 15, paragraph 2, 17, paragraph 3, and page 27, lines 11-13; alloys thereof described inter alia on page 27, line 11; a lubricating metal chalcogen compound described inter alia on page 17, lines 8-9 from the bottom, page 27, lines 3-6; halide described inter alia on page 27, lines 8, 9; carbonate described inter alia on page 27, lines 9-10; silicate described inter alia on page 10, line 11, page 13, first full paragraph; or phosphate described inter alia on page 27, lines 17-18; or a particulate lubricating metal nitride described inter alia on page 27, line 8; or a carbon lubricant described inter alia on page 4, line 10, page 13, line 5 from the bottom of the page, page 14, line 13, page 40 lines 9-10 from the bottom of the page; or
- (2) a silicate ester described inter alia on page 13, first full paragraph; polyphenyl ether described inter alia on page 10, line 11; organic phosphate described inter alia on page 8, lines 5-6 from the bottom, page 10, line 10; chlorinated biphenyl page 12, line 11; phenanthrene described inter alia on page 17, line 7, page 27, line 2 from the bottom; or a phthalocyanine compound described inter alia on page 13, last line page 14, line 5 from the bottom, page 17, lines 7-10;
- (3) where the material for lubricating a surface optionally contains a lubricant comprising an, organic lubricant described inter alia on page 17, paragraph 2, page 22, first full paragraph, the paragraph bridging pages 27-28, the paragraph bridging pages 28-29, inorganic lubricant described inter alia in the paragraph bridging pages 15-16 to paragraph 1 on page 17, or lubricant additive described inter alia on pages 7-10;
- (4) or mixtures thereof described inter alia in the paragraph bridging pages 23-24 through line 2 of page 25, page 26, first full paragraph, page 26 second full paragraph, page 28, first full paragraph to page 29, first full paragraph.

Independent claim 74 relates to that aspect of the invention comprising a lubricant composition of matter comprising a product produced by the process of claim 73. This brief gives the claim 73 references to the page number and line or paragraph numbers of the written description.

Independent claim 76 relates to that aspect of the invention which is a lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where the polymer comprises a superabsorbent polymer, the mixture further comprising a material for lubricating a surface, wherein the superabsorbent polymer absorbs more than about 100 times its weight in water and wherein the material for lubricating a surface comprises a solid lubricant comprising a metal alloy, an inorganic chalcogen compound, halide, nitride, carbonate, phosphate compound, carbon lubricant, or metal material that provides barrier-layer lubrication, or mixtures thereof, and wherein the composition optionally comprises a lubricant additive. The written description describes this product by process aspect of the invention inter alia in the paragraph bridging pages 20-21. Claim 73 includes all of the elements of claim 76, and this brief recites the claim 73 references to the page number and line or paragraph numbers of the written description that support these elements.

Independent claim 80 relates to that aspect of the invention which is a lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where the polymer comprises a superabsorbent polymer, wherein the superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, the mixture further comprising a material for lubricating a surface, wherein the superabsorbent polymer absorbs more than about 100 times its weight in water, and wherein the material for lubricating a surface comprises water containing a lubricant

additive. The foregoing discussion of claim 73 in this brief indicates where the written description supports all of the claim 80 elements but for the element comprising water containing a lubricant. The written description supports this inter alia at page 25, lines 17-19.

Independent Claim 81 relates to that aspect of the invention which is a lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a superabsorbent polymer, wherein the superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, the mixture further comprising a material for lubricating a surface, wherein the superabsorbent polymer absorbs more than about 100 times its weight in water, and wherein the material for lubricating a surface comprises an oil or greases thereof and water, and wherein the composition optionally comprises a lubricant additive. The foregoing discussion of claim 73 in this brief indicates where the written description supports all of the claim 81 elements but for the element comprising an oil or greases thereof and water. The written description supports this inter alia at page 26, paragraph 4, page 25, line 19, page 26, line 2, and page 28, first full paragraph, and page 29, lines 11-20.

Independent Claim 82 relates to that aspect of the invention which is a lubricant composition of matter comprising a lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where the polymer comprises a superabsorbent polymer, wherein the superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, the mixture further comprising a material for lubricating a surface, wherein the superabsorbent polymer absorbs more than about 100 times its weight in water, wherein the material for lubricating a surface comprises a solid lubricant and water, and wherein the

composition optionally comprises a lubricant additive. The foregoing discussion of claim 81 in this brief indicates where the written description supports all of the claim 82 elements.

Independent Claim 84 relates to that aspect of the invention which is a lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where the polymer comprises a superabsorbent polymer, the mixture further comprising a material for lubricating a surface, wherein the superabsorbent polymer absorbs more than about 100 times its weight in water, wherein the material for lubricating a surface comprises a phosphate, and wherein the composition optionally comprises a lubricant additive. The foregoing discussion of claim 73 in this brief indicates where the written description supports all of the claim 84 elements.

Dependent claim 89 relates to that aspect of the invention comprising a substantially anhydrous composition. Pages 31-32 and Example I inter alia on pages 33-34 of the written description support the substantially anhydrous parameter.

(vi) **Grounds of Rejection to be Reviewed on Appeal**

- a. Whether the judicially created doctrine of obviousness-type double patenting applies to claims 73 -100 taken in view of claims 57-90 of copending application Serial No. 10/614,114 filed July 7, 2003 and claims 90 -115 of copending application Serial No. 10/763,687 filed January 24, 2004.
- b. Whether the examiner has properly applied 35 U.S.C. 112, first paragraph in rejecting claim 89 relating to a substantially anhydrous composition.
- c. Whether Takayama, United States Patent No. 5,792,717 supports the examiner's rejection of claims 73, 74, 76, 77 and 90 under 35 U.S.C. § 103(a);

- d. Whether Johnson, United States Patent No. 5, 275,760 in view of Obayashi et al. United States Patent No. 4,340,706 ("Obayashi") support the examiner's rejection of claims 73-76, 80-82, 86, 87, 89-93, 96, 98, and 100 under 35 U. S. C. § 103 (a);

(vii) Argument

The Provisional Double Patenting Rejection

The examiner provisionally rejects claims 73-100 under the judicially created doctrine of obviousness-type double patenting based on copending applications Serial No. 10/614,114 filed July 7, 2003 and Serial No. 10/763,687 filed January 24, 2004. Appellant traverses the rejection since neither copending application has issued as a patent, and further requests allowance if neither of the copending applications issues, and the only rejection remaining in the present application consists of the provisional obviousness-type double patenting rejection. If one of the co-pending applications issues as a patent, appellant reserves the right to distinguish the claims in this application from the claims of the copending application or applications in the event this application still remains as a pending application at the time of issue of one of the other applications.

Appellant should not be required to file a terminal disclaimer in the present application since the Patent Office may not allow the copending applications (Serial No. 10/614,114 filed July 7, 2003 and Serial No. 10/763,687 filed January 24, 2004) which form the basis of the double patenting rejection. When a provisional double patenting rejection is the sole remaining rejection in an earlier filed application, (the present application, Serial No. 09/359,809, filed July 21, 1999) and the present application is otherwise in condition for allowance, the M.P.E.P. states that the examiner should withdraw the rejection in the application and permit it to issue as a patent. M.P.E.P. § 804(I) (B).

The Rejection Under 35 U.S.C. §112 First Paragraph

The examiner rejects claim 89 allegedly for lacking support in the specification for a composition that is substantially anhydrous. Appellant previously pointed out that the written description of the parent application supports a composition that is substantially anhydrous at p. 29, 2nd par., but the examiner, upon reviewing appellant's argument in view of this part of the written description states "[t]hat the composition may have the consistency of grease is not adequate support for a substantially anhydrous composition." (May 24, 2006 Office communication, page 4, par. 4). The examiner apparently did not refer to the parent application, but rather the present application page 29 discussion. But the present application also discusses this phenomenon at pages 31 and 32 as follows:

The lubricant and additives, when employed, are combined with the superabsorbent polymer by swelling the polymer either by itself or dispersed with the lubricant (and additives when employed), either in water or in a high humidity environment, e.g. 80% R.H.

Prior to, or after exposing the superabsorbent polymer to water or humidity, the polymer, in the form of a powder, flakes or granules is mixed with the lubricant in a conventional mixer, such as a HOBART™ mixer until a uniform dispersion is obtained. This process may be facilitated by employing a solvent or dispersant for the lubricant, preferably in some instances, one that will be easily driven off from the lubricant composition of the invention, such as a ketone, especially the lower alkyl ketones e.g. acetone MEK, MIBK, DIBK, and the like.

The lubricant then combines with, is entrapped by or is taken up by the superabsorbent polymer that has been swollen with water or in high humidity. The lubricant composition is then dried to remove the water, for example by placing it in a 27-38% R.H. environment, or under vacuum or at elevated temperatures. This removes substantially all of the water introduced in the first part of the process. (emphasis added)

The Rejection Under 35 U.S.C. §103 (a)

The examiner rejects claims 73, 74, 76, 77, and 90 under 35 U. S. C. § 102 (e) as obvious in view of Takayama, United States Patent No. 5,792,717. The examiner cites

Takayama for the disclosure of a monolithic boron nitride ceramic body article of manufacture that has open pores filled with a water absorbing resin. This is not appellant's particulate boron nitride composition combined with a superabsorbent resin. Claiming the metal nitride as a particulate material distinguishes Takayama which describes an article of manufacture based on a boron nitride monolith or ceramic.

To apply this reference to reject the present claims would require taking the Takayama article and using it to lubricate a substrate, e.g., putting the Takayama article of manufacture between two sliding surfaces that frictionally engage one another. Standing by itself, it does not teach appellant's claimed particulate composition.

The examiner also states that "Takayama teaches the composition has lubricity properties (see col.4, lines 30-43)." (May 24, 2006 Office communication, p. 5, 2nd par.) Appellant respectfully disagrees. This section of the Takayama reference only describes the porosity of the monolithic ceramic substrate. It does not say anything about the lubricity of the combination, but only that water can provide increased lubrication by impregnating a water absorbing polymer into the porous ceramic in increased amounts. The inventor achieves this by employing a monolithic ceramic material with relatively high porosity. Takayama therefore does not obviate appellant's claimed particulate metal nitride lubricating composition.

The examiner rejects claims 73-76, 80-82, 86, 87, 89-93, 96, 99, and 100 under 35 U. S. C. § 103 (a) as unpatentable over Johnson, United States Patent No. 5, 275,760 in view of Obayashi et al. United States Patent No. 4,340,706 ("Obayashi").

Johnson does not teach or suggest:

A lubricating composition of matter comprising a polymer, where the polymer comprises a superabsorbent polymer that absorbs greater than about 100 times its weight in water combined with a material for lubricating a surface wherein the material for lubricating a surface comprises:

- (1) a lubricating metal and alloy thereof, a lubricating metal chalcogenide, halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant; or
- (2) a silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene, or phthalocyanine compound;
- (3) where the material for lubricating a surface optionally contains a lubricant comprising an, organic lubricant, inorganic lubricant, or water, or a lubricant additive; or
- (4) mixtures thereof.

On the contrary, Johnson describes the use of "oils" with a polymer, noting that "[o]ils are a suitable carrier medium [that] . . . include fixed oils such as glycerol fatty acids, lubricating oils, mineral oils, hydrocarbon oils such as crude petroleum, residual refinery oils from bottom streams, diesel oils, fuel oils and the like. In the present method, a food grade mineral oil is preferred. . . ." (Johnson, col. 4, lines 24-29). These bear no chemical resemblance to the claim 73 inorganic materials for lubricating a surface or the "silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene, or phthalocyanine compound" class of materials for lubricating a surface.

The examiner correctly distinguishes the broader teachings of Johnson at page 6 of her May 24 Office communication, i. e., Johnson fails to teach appellant's intended use, although the examiner argues intended use does not lend patentable weight to appellant's invention, and Johnson fails to teach superabsorbent polymers, i.e., polymers that absorb more than about 100 times their weight in water. Appellant nonetheless distinguishes the reference not only for the reasons given by the examiner, but also as noted above because it fails to teach or suggest the use of an inorganic lubricating material or the "silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene, or phthalocyanine compound" class of materials for

lubricating a surface. Obayashi does not overcome these deficiencies of the Johnson reference.

Conclusions

Appellant requests the Board to reverse the examiner in all respects and remand the application to the examiner for the issuance of a Notice of Allowance. If the Board overrules the prior art and 35 U.S.C. § 112 rejections in this application and sustains the provisional double patenting rejection, appellant similarly requests the Board to remand the application to the examiner for issuance of a Notice of Allowance pursuant to M.P.E.P. § 804(I) (B).

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

By: / Robert J. Eichelburg, Reg. No 23,057/

Dated: August 8, 2007

Robert J. Eichelburg

CERTIFICATE OF FACSIMILE TRANSMISSION PURSUANT TO 37 C.F.R. § 1.6 (d)

I hereby certify that the foregoing Brief on Appeal and the attached FORM PTO 2038 is being transmitted pursuant to 37 C.F.R. § 1.6(d) by facsimile to The United States Patent and Trademark Office, facsimile telephone number (571) 273-8300 on the date indicated below.

By: /Robert J. Eichelburg, Reg. No. 23,057/
Robert J. Eichelburg

Dated: August 8, 2007

(viii) Claims Appendix

Claim 73 A process for manufacturing a lubricant composition comprising a polymer where said polymer comprises a superabsorbent polymer that absorbs more than about 100 times its weight in water, by combining said polymer with a material for lubricating a surface wherein said material for lubricating a surface comprises:

- (1) a lubricating metal and alloys thereof, a lubricating metal chalcogen compound, halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant; or
- (2) a silicate ester, polyphenyl ether, organic phosphate, chlorinated biphenyl, phenanthrene or phthalocyanine compound;
- (3) said material for lubricating a surface optionally containing a lubricant comprising an, organic lubricant, inorganic lubricant, or lubricant additive;
- (4) or mixtures thereof.

Claim 74 A lubricant composition of matter comprising a product produced by the process of claim 73.

Claim 75 The lubricant product of claim 74 wherein said organic lubricant comprises a petroleum oil lubricant or grease thereof, a fatty oil, fatty acid, wax, synthetic oil lubricant or grease thereof, two-mol ethoxylate of isostearyl alcohol, a soap, a polymerized olefin, or an organic ester and wherein said composition optionally comprises a lubricant additive, or mixtures thereof.

Claim 76 A lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where said polymer comprises a

superabsorbent polymer, said mixture further comprising a material for lubricating a surface, wherein said superabsorbent polymer absorbs more than about 100 times its weight in water and wherein said material for lubricating a surface comprises a solid lubricant comprising a metal alloy, an inorganic chalcogen compound, halide, nitride, carbonate, phosphate compound, carbon lubricant, or metal material that provides barrier-layer lubrication, or mixtures thereof, and wherein said composition optionally comprises a lubricant additive.

Claim 77 The lubricant composition of claim 76, wherein said material for lubricating a surface comprises, molybdenum disulfide, cobalt chloride, antimony oxide, niobium selenide, tungsten disulfide, boron nitride, silver sulfate, cadmium chloride, cadmium iodide, cadmium oxide, borax, basic white lead, lead carbonate, lead monoxide, lead iodide, asbestos, talc, mica, zinc oxide, zinc phosphate, iron phosphate, manganese phosphate, carbon, graphite, babbitt, bronze, brass, aluminum, gallium, indium, thallium, thorium, copper, silver, gold, mercury, lead, tin, indium, or the Group VIII noble metals or mixtures thereof.

Claim 78 The lubricant composition of claim 74 wherein said organic lubricant comprises a solid organic lubricant.

Claim 79 The lubricant composition of claim 78, wherein said solid organic lubricant comprises a fluoroalkylene homopolymer or copolymer, a lower alkylene polyolefin homopolymer or co-polymer, a paraffinic hydrocarbon wax, phenanthrene, copper phthalocyanine, or mixtures thereof.

Claim 80 A lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where said polymer comprises a superabsorbent polymer, wherein said superabsorbent polymer comprises a polymer of acrylic

acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, said mixture further comprising a material for lubricating a surface, wherein said superabsorbent polymer absorbs more than about 100 times its weight in water, and wherein said material for lubricating a surface comprises water containing a lubricant additive.

Claim 81 A lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a superabsorbent polymer, wherein said superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, said mixture further comprising a material for lubricating a surface, wherein said superabsorbent polymer absorbs more than about 100 times its weight in water, and wherein said material for lubricating a surface comprises an oil or greases thereof and water, and wherein said composition optionally comprises a lubricant additive.

Claim 82 A lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where said polymer comprises a superabsorbent polymer, wherein said superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, said mixture further comprising a material for lubricating a surface, wherein said superabsorbent polymer absorbs more than about 100 times its weight in water, wherein said material for lubricating a surface comprises a solid lubricant and water, and wherein said composition optionally comprises a lubricant additive.

Claim 83 The lubricant composition of claim 82, wherein said solid lubricant comprises molybdenum disulfide, cobalt chloride, antimony oxide, niobium selenide, tungsten disulfide, boron nitride, silver sulfate, cadmium chloride, cadmium iodide, cadmium oxide, borax, basic

white lead, lead carbonate, lead monoxide, lead iodide, asbestos, talc, mica, zinc oxide, zinc phosphate, iron phosphate, manganese phosphate, carbon, graphite, babbitt, bronze, brass, aluminum, gallium, indium, thallium, thorium, copper, silver, gold, mercury, lead, tin, indium, the Group VIII noble metals, a fluoroalkylene homopolymer or copolymer, a lower alkylene polyolefin homopolymer or co-polymer, a paraffinic hydrocarbon wax, phenanthrene, copper phthalocyanine, or mixtures thereof.

Claim 84 A lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where said polymer comprises a superabsorbent polymer, said mixture further comprising a material for lubricating a surface, wherein said superabsorbent polymer absorbs more than about 100 times its weight in water, wherein said material for lubricating a surface comprises a phosphate, and wherein said composition optionally comprises a lubricant additive.

Claim 85 The lubricant composition of claim 84, wherein said material for lubricating a surface comprises tricresyl phosphate, zinc phosphate, iron phosphate or manganese phosphate, or mixtures thereof.

Claim 86 The lubricant composition of claim 74 wherein said organic lubricant comprises a fatty oil, fatty acid, or wax, or mixtures thereof, and wherein said composition optionally comprises a lubricant additive.

Claim 87 The lubricant composition of claim 74 wherein said organic lubricant comprises a synthetic oil lubricant, or grease thereof, and wherein said composition optionally comprises a lubricant additive.

Claim 88 The lubricant composition of claim 74 wherein said organic lubricant comprises a soap, and wherein said composition optionally comprises a lubricant additive.

Claim 89 The composition of any one of claims 73-79, and 84-88 wherein said composition is substantially anhydrous.

Claim 90 The composition of any one of claims 73-79, and 84-88 wherein said superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof.

Claim 91 The composition of any one of claims 75-88 wherein said lubricant additive comprises an antioxidant, rust inhibitor, antiwear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor, or mixtures thereof.

Claim 92 The composition of claim 75 wherein said organic lubricant comprises a petroleum oil lubricant or grease thereof.

Claim 93 The composition of claim 75 wherein said organic lubricant comprises a fatty oil.

Claim 94 The composition of claim 75 wherein said organic lubricant comprises a fatty acid.

Claim 95 The composition of claim 75 wherein said organic lubricant comprises a wax.

Claim 96 The composition of claim 75 wherein said organic lubricant comprises a synthetic oil lubricant or grease thereof.

Claim 97 The composition of claim 75 wherein said organic lubricant comprises a two-mol ethoxylate of isostearyl alcohol.

Claim 98 The composition of claim 75 wherein said organic lubricant comprises a soap.

Claim 99 The composition of claim 75 wherein said organic lubricant comprises a polymerized olefin.

Claim 100 The composition of claim 75 wherein said organic lubricant comprises an organic ester.

(ix) Evidence Appendix

Appellant submits no evidence.

(x) Related Proceedings Appendix

Appellant attaches a copy of the Board's February 27, 2006 decision in application Serial No. 08/943,125 and a certified copy of the file jacket of application Serial No. 08/943,125 showing the Patent and Trademark Office labeled it as an application involved in an interference. Appellant submitted a copy of the file jacket of application Serial No. 08/943,125 to the Board in that appeal.

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

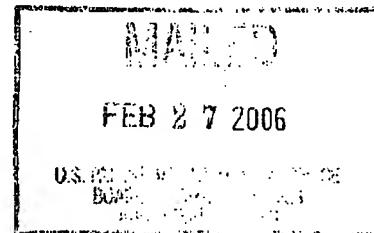
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD LEVY

Appeal No. 2005-2667
Application 08/943,125

ON BRIEF:



Before PAK, WARREN and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

ORDER VACATING ORAL HEARING

On January 25, 2006, Mr. Craig R. Feinberg, a Program and Resources Administrator of the Board of Patent Appeals and Interferences, informed appellant's counsel, Mr. Robert J. Eichelburg, that the Merits Panel assigned to this application had decided to reverse the decision of the examiner. Mr. Feinberg further informed Mr. Eichelburg that therefore, the Oral Hearing scheduled for January 25, 2006, will be vacated.

Accordingly, as counsel was informed on January 25, 2006, it is ORDERED that the Oral Hearing scheduled for 1:00 PM on January 25, 2006, is *VACATED*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, and based on our review, find that we cannot sustain the rejection of appealed claims 43, 44, 49, 50, 55 and 56 under 35 U.S.C. § 102(b) as being anticipated by the Geursen et al. (Geursen) references

Appeal No. 2005-2667
Application 08/943,125

United States Patent 5,534,304 ('304 reference) and WO 93/18223 ('223 reference)¹, which are in the same patent family (answer, pages 3-5 and 6-7).^{2,3}

We refer to the answer and to the brief and reply brief for a complete exposition of the positions advanced by the examiner and appellant.

It is well settled that the examiner has the burden of making out a *prima facie* case of anticipation in the first instance by pointing out where each and every element of the claimed invention, arranged as required by the claim, is described identically in a single reference, either expressly or under the principles of inherency, in a manner sufficient to have placed a person of ordinary skill in the art in possession thereof. *See In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Whether the teachings and inferences that one skilled in this art would have found in the disclosure of an applied reference would have placed this person in possession of the claimed invention, taking into account this person's own knowledge of the particular art, is a question of fact. *See generally, In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), and cases cited therein (a reference anticipates the claimed method if the step that is not disclosed therein "is within the knowledge of the skilled artisan."); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) ("[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom."). While it is entirely appropriate to rely on another reference to clarify a fact in the anticipating reference; *see generally, In re Samour*, 571 F.2d 559, 562, 197 USPQ 1, 4 (CCPA 1978), the supporting reference must in fact accomplish that purpose.

The principal issue in this ground of rejection is whether the lubricating compositions

¹ The answer incorrectly identifies the '223 reference as "WO 93/18233."

² The examiner withdrew the ground of rejection of appealed claims 45 through 48, 51 through 54, 57 and 58 under 35 U.S.C. § 103(a) as being unpatentable over the Geursen et al. references further in view of the admitted prior art and Sayad et al., set forth in the Office action mailed May 24, 2002 (pages 5-7) and maintained in the Office action mailed December 18, 2003. The examiner objected to these claims as containing allowable subject matter but dependent on a rejected base claim (answer, page 2). We consider the ground of rejection under the judicially created doctrine of obviousness type double patenting below.

³ Claims 43 through 48 are all of the claims in the application. *See* page 2 and the appendix of the brief filed March 13, 2003, which we consider on appeal.

containing any "superabsorbent polymer which absorbs greater than about 100 times its weight in water" in the claimed method of lubricating a surface, encompassed claim 43, and the lubricating compositions containing any "superabsorbent polymer which absorbs greater than about 100 times its weight in water and is a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof" in the claimed method of lubricating a surface, encompassed in the remainder of the rejected claims, would have been described to one skilled in this art within the meaning of § 102(b) by the Geursen references.

The examiner takes the position that the Geursen references teach compositions which contain "a superabsorbent material" that is disclosed to be "capable of absorbing and holding a comparatively large quantity of water" which can be made from absorbent derivatives of polyacrylic acid including homo- and copolymers derived from acrylic acid and acrylamide (answer, page 3) ('223 reference, page 6, ll. 5-32; '304 reference, col. 3, ll. 33-67). In the statement of the ground of rejection, the examiner does not identify any specific polymer disclosed *per se* in the Geursen references as meeting the subject claim limitations, but contends that

Geursen incorporates the teachings of Arroyo et al (Arroyo) EP 0,351,100^{4,5}] that the [superabsorbent material] includes the ARIDALLTM] polymers that are known to absorb greater than 100 times its weight in water. Appellant makes admission on record at page 21 to the bridging paragraph of pages 22-23 of the instant specification that conventional known [superabsorbent material] that absorbs greater than 100 times its weight in water of the Admitted Prior Art are the [superabsorbent material] used in the instant claims. Appellant makes admission on record at line 17 of [page 22] of the instant specification that the ARIDALLTM] POLYMERS of the Admitted Prior Art of Arroyo is the [superabsorbent material] used in the instant claims. [Answer, page 4.]

Contrary to appellant's contentions (brief, page 14; reply brief, page 2), the Geursen references teach that insoluble superabsorbent materials that can be used include those "mentioned in . . . [Arroyo]" which are described as "derived from an aqueous solution comprising an acrylate polymeric material which combines acrylic acid and sodium acrylate

⁴ European Patent Application published January 17, 1990.

⁵ We cannot find Arroyo in a PTO-892, a PTO-1449 or elsewhere in the official electronic file of the USPTO for this application. Thus, if the examiner cannot locate evidence in the official electronic file of the USPTO for this application that Arroyo was made of record, the examiner should make it of record.

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functionalities and water" ('223 reference, page 2, ll. 10-17, and page 6, ll. 9-11; '304 reference, col. 1, ll. 45-53, and col. 3, ll. 37-40). We find that Arroyo describes superabsorbent materials generally, including those based on polyacrylic acid and polyacrylonitrile, and discloses that "[t]he preferred superabsorbent material is Aridall™ 1125F Superabsorbent Polymer available from the Chemdal Corporation," and that "Aridall polymers are crosslinked acrylic polymers" (col. 5, l. 35, to col. 7, l. 1).

Appellant discloses in the written description in the specification that "[t]he superabsorbent polymer employed according to the invention, absorbs from about 25 to greater than 100 times its weight in water and comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile or acrylamide, including co-polymers thereof or starch graft copolymers thereof or mixtures thereof, where the mixtures contain from 2 to about 3 or 4 superabsorbent polymers" (page 21, ll. 1-7). Appellant further discloses that the superabsorbent polymers include those listed in certain United States Patents as well as certain commercially available polymers (pages 21-23). Included among the latter is "Aridall™ which are sodium or potassium polyacrylates that may be lightly cross-linked" (page 22, ll. 17-18).

Appellant argues in the brief that the "swelling value" disclosed in Geursen references includes "the relative water absorbency of the yarn or the yarn coated with the superabsorbent polymer composition," and provides a supporting explanation based on the disclosure in Example I, including Table A, of the references for the contention that the same would not have disclosed "superabsorbent polymers that can absorb greater than about 100 times their weight in water" (brief, pages 6-10 and 12; *see* reply brief, page 6). The composition includes "Mirox W 45985" which is a superabsorbent polymer that "is a terpolymer of acrylamide, carboxyl groups- and sulfo groups-containing polymers" ('223 reference, pages 15-17; '304 reference, cols. 8-9).

In response to appellant's arguments in the brief, the examiner points to the disclosure in the Geursen references that "[d]epending on the nature of the substrate and the quantity and nature of the superabsorbent material applied thereto, the swelling values ranges from 50 to 700 or higher, more particularly from 100 to 700 or higher" ('223 reference, page 2, ll. 10-17, and page 6, ll. 9-11; '304 reference, col. 7, ll. 2-6) (answer, page 6).

Appellant points out in the reply brief that "neither[the Geursen references] nor Arroyo claim that the ARIDALL™ 1125F disclosed in Arroyo can absorb greater than 100 times its weight in water," and that this material is not disclosed in his specification (pages 3-4). Appellant states that "an internet search" did not "find" this material (*id.*, page 3).

On this record, we agree with appellant that the examiner has not identified any evidence in the Geursen references and Arroyo which support the ground of rejection. In order to factually support the ground of rejection, the examiner must establish as a matter of fact that at least one superabsorbent material in the references met the subject claim limitations in the appealed claims. This cannot be accomplished by combining a disclosed general range of absorbent values of superabsorbent materials which overlaps the claimed absorbent range of "greater than about 100 times its weight in water," with a particular superabsorbent material, and especially since there is no disclosure in any of the references or in appellant's specification which would place the particular species within the claimed absorbent range, either expressly or under the principles of inherency. *See Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 780, 227 USPQ 773, 777 (Fed. Cir. 1985) ("[A]nticipation under § 102 can be found only when the reference discloses exactly what is claimed."). Therefore, the examiner has not established a *prima facie* case of anticipation under 35 U.S.C. § 102(b) as a matter of fact and accordingly, we reverse this ground of rejection.

Other Issues

Upon further consideration of the appealed claims by the examiner subsequent to the disposition of this appeal, the examiner should consider whether the Geursen references alone (see, e.g., Geursen '223, page 5, l. 19, to page 6, l. 32, and page 12, l. 18, to page 13, l. 3), or together with appellant's admissions in the specification (page 21, l. 1, to page 23, l. 4), which suggest that superabsorbent materials that absorb greater than about 100 times their weight in water were known, affect the patentability of the claimed invention under 35 U.S.C. § 103(a).

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §1.41.50(a)(1) (2005); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 2, May 2004; 1200-29 – 1200-30).

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The examiner provisionally rejected appealed claims 43 through 57⁶ under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 72 through 86 of then copending application 08/943,123 (answer, pages 5-60). This application has since matured into United States Patent 6,734,147 ('147 patent), issued May 11, 2004.

Appellant filed a terminal disclaimer along with the reply brief on December 8, 2003, "to overcome the double patenting rejection" (reply brief, page 9). The examiner acknowledged that the terminal disclaimer "is proper and has been entered into the file," but did not state the status of the ground of rejection in view thereof in the communication mailed February 27, 2004.

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to determine whether the terminal disclaimer overcomes the ground of rejection, and if not, to state the ground of rejection based on the appealed claims vis-à-vis the claims of the '147 patent, setting forth the status of appealed claim 58 in this respect, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

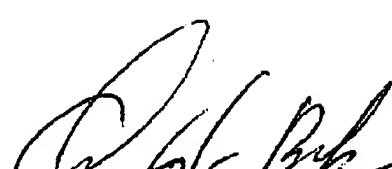
This remand is made for the purpose of directing the examiner to further consider the ground of rejection. Accordingly, if the examiner submits a supplemental answer to the Board in response to this remand, "appellant must within two months from the date of the supplemental examiner's answer exercise one of" the two options set forth in 37 CFR §1.41.50(a)(2) (2005), "in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding," as provided in this rule.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

⁶ The examiner did not include appealed claim 58 in this ground of rejection (answer, page 5; Office action mailed May 24, 2002, page 7; Office action mailed December 18, 2003, page 3), and thus this claim stands unrejected on appeal.

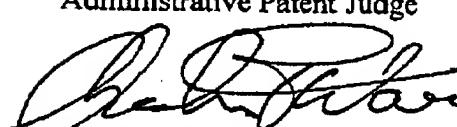
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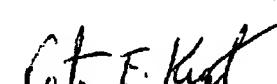
CHUNG K. PAK

Administrative Patent Judge



CHARLES F. WARREN

Administrative Patent Judge



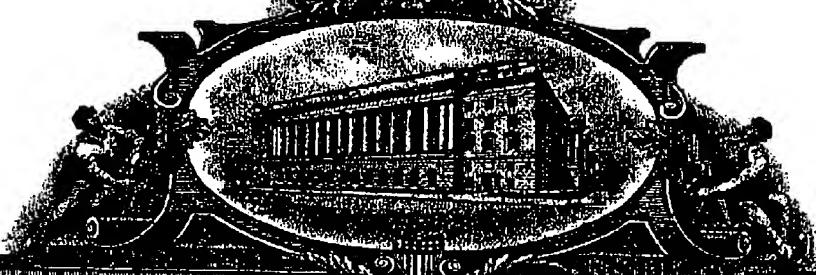
PETER F. KRATZ

Administrative Patent Judge

)
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Appeal No. 2005-2667
Application 08/943,125

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PM 264278

THE UNITED STATES OF AMERICA

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August 21, 2000

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SERIAL NUMBER: 08/943,125

FILING DATE: October 03, 1997



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L. EDELEN
Certifying Officer

RETURNS COOK

APPLICANT		NAME		DATE RECEIVED		EXAMINER				
SERIAL NUMBER 06/497,436		FILING DATE 10/03/97		CLASS 252		SUBCLASS 508				
RICHARD LEVY, MYERS, FL.				009 110		GROUP ART UNIT 1111 1721				
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CONTINUING DATA* VERIFIED THAT APPLN IS A CON OF 06/497,436 06/07/95 <i>MBm</i>										
SPONSORSHIP/PCT APPLICATIONS* VERIFIED <i>MBm</i>										
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Verified and Acknowledged		Examiner's Initials								
ADDRESS		FINNEMAN HENDERSON FARABOW GARNETT AND DUNNER 1300 I STREET NW WASHINGTON DC 20005-3315								
TITLE		LUBRICANT COMPOSITIONS AND METHODS								
U.S. DEPT. OF COMM./PAT. & TM. PTO-436L (Rev.12-95)										

PARTS OF APPLICATION FILED SEPARATELY		Applications Examined	
NOTICE OF ALLOWANCE MAILED		NUMBER OF CLAIMS ALLOWED	
		Total Claims	Printed
		1	1
ISSUE FEE		DRAWING FEE	
Amount Due	Date Paid	Sheets Drawn	Drawings
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